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PATENT
Attorney Docket No. 90204-750645 (002300)
Client Ref. No. REG00559 2003 PT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Nathan Blake Scholl, et al.

Application No.: 10/748,759

Filed: December 30, 2003

For: METHOD AND SYSTEM FOR GENERATING AND PLACING KEYWORD-TARGETED ADVERTISEMENTS

Confirmation No. 2699

Examiner: RETTA, YEHDEGA

Technology Center/Art Unit: 3622

REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Appellants offer this Reply Brief in response to the Examiner's Answer mailed April 14, 2011. The arguments herein supplement the arguments made in Appellants' Appeal Brief filed January 19, 2011.

STATUS OF CLAIMS

Claims 3, 5, 15, 22-34 have been previously canceled from the present application.

Claims 1, 2, 4, 6-14, 16-21, 35 and 36 are currently pending.

Claims 1, 2, 4, 6-14, 16-21, 35 and 36 stand rejected under 35 U.S.C. § 103.

Currently pending claims 1, 2, 4, 6-14, 16-21, 35 and 36 are the subject of this appeal.

No other claims are pending.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Issue 1: Whether claims 1, 2, 4, 6-14, 16-21, 35, and 36 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Calabria et al. (US 2005/0137939 A1) (hereinafter "Calabria") in view of Ford et al. (US 6,606,644 B1) (hereinafter "Ford").

For the purposes of this Appeal, Appellants will treat Calabria and Ford as prior art. However, Appellants reserve the right to later disqualify these references as prior art.

ARGUMENT

Under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not. M.P.E.P. § 2142. Accordingly, "the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2142; *see KSR International Co. v. Teleflex, Inc.*, 550 U.S.398, 82 USPQ 2d 1385, 1395-97 (2007).

As set forth in detail below, Applicant submits that the rejection of claims 1, 2, 4, 6-14, 16-21, 35, and 36 under 35 U.S.C. § 103(a) in the Supplemental Final Office Action mailed August 10, 2010 ("the Final Office Action") is deficient in one or more of these respects and therefore fails to establish a prima facie case of obviousness. Accordingly, Applicants respectfully request that the rejection be overturned.

Independent Claim 1

A. The Cited References Do Not Disclose, Teach or Suggest the "Plurality of Advertisement Generators" Recited in Claim 1

In the Appeal Brief, Appellants argued that the rejection of claim 1 is improper because, among other reasons, Calabria does not teach or suggest "a plurality of advertisement generators," where the generators "identify search terms corresponding to an item," "determine at least one item-specific visual element," "create a link to information about the item," and "generate an advertisement set for the item that includes at least one associated advertisement having the item specific visual element, the link, and at least one search term matching the at least one keyword," as recited in Appellants' claim 1. In response, the Examiner's Answer points to the following portions of Calabria: [0052]-[0055], [0121] and [0069]-[0072]. Each of these portions of Calabria will be discussed in turn.

[0052]-[0055], [0121]: These paragraphs of Calabria describe a "keyword selection agent 52," an "advertisement selection agent 54," and a "Return on Advertising Investment (ROAI) agent 56." According to these paragraphs, the keyword selection agent 52 selects "keywords and keyword combinations" from a " keyword database 48," and the advertisement selection agent

54 selects "an advertisement" from an "advertisement database 46," where the selected advertisement "is to be matched with a given keyword or keyword combination." The ROAI agent 56 "provides an estimate of return on investment for one or more bids or a range of bids associated with a given keyword/keyword combination and matched [] advertisement."

Specifically, according to these paragraphs of Calabria, the keyword selection agent 52 can select optimized keywords:

> i) based on the content of the advertiser web site 18, ii) for each advertisement in the advertisement database 46 based on the content of the advertisement, iii) based on the frequency that certain keywords are included in queries to the keyword search engine, iv) from information provided by the advertiser feedback database 42 in the keyword search engine 12, v) from information provided via input device 19, and/or vi) from information provided by other relevant sources.

Similarly, the advertisement selection agent 54 can "select optimized advertisements: i) based on optimized keyword selection, ii) based on optimized ROAI, iii) from information provided via input device 19, iv) from information provided by the advertiser feedback database 42, and/or v) from information provided by other relevant sources."

The Examiner's Answer on page 4 seems to suggest that by disclosing the "keyword selection agent 52" and its "selection of keyword or keyword combinations," these paragraphs of Calabria teach the "advertisement generators" that "identify search terms corresponding to an item," as recited in claim 1. However, Appellants disagree and respectfully assert that Calabria's "selection of keywords and keyword combinations" is different than the claimed "identify[ing] search terms corresponding to an item." According to Calabria, the "keyword selection agent 52" selects "keywords and keyword combinations" based on, for example, the content of web sites and advertisements, and the advertisement selection agent 54 selects advertisements that are to be matched with the selected keywords and keyword combinations. Thus, these paragraphs of Calabria disclose selecting keywords and corresponding advertisements. In contrast, claim 1 recites, "identify[ing] search terms corresponding to an item."

Further, it appears to be suggested on page 4 of the Examiner's Answer that by disclosing an advertisement selection agent 54 that selects an "advertisement" from an advertisement

database 46, Calabria teaches "advertisement generators" that "determine at least one item-specific visual element," as recited in claim 1. However, the selecting an advertisement as disclosed in Calabria is not relevant to the "determin[ing] at least one item-specific visual element" of claim 1. For example, according to these paragraphs of Calabria, the advertisement selection agent 54 selects advertisements based on, for example, keyword selections and ROAI information, and the selected advertisements are matched with corresponding keywords. Accordingly, the cited paragraphs of Calabria are entirely unrelated to "determin[ing] at least one item-specific visual element," as recited in claim 1.

Still further, it appears to be asserted on page 9 of the Examiner's Answer that paragraph [0052] of Calabria teaches the claimed "create a link to information about the item." However, Appellants disagree. Paragraph [0052] discloses that the "ROAI agent 56 may receive, for example, click-through information associated with a given keyword/keyword combination and matched keyword advertisements from the advertiser feedback database 42." Appellants assert that this does not disclose or suggest the "advertisement generators" that "create a link to information about the item," as recited in claim 1. Nothing in paragraph [0052] or the other cited paragraphs of Calabria is related to creating a link, where the link is a link to information about an item.

[0069]-[0072]: These paragraphs of Calabria disclose that, for each keyword, the corresponding advertisements are ranked in descending order based on whether the advertisements are appealing advertisements for the particular keywords in question. Examples provided in Calabria indicate that a "Cheap mortgages!" advertisement is an appealing and therefore highly ranked advertisement for the keyword "mortgage," but "Overpriced mortgages" is a less appealing and therefore lower ranked advertisement. According to these paragraphs of Calabria, whether an advertisement is appealing is determined based on "the ClickthruRate" and "the ROAI" of the advertisements. These paragraphs of Calabria also discloses techniques for calculating ClickthruRate and ROAI.

As indicated on page 4 of the Examiner's Answer, the rejection to claim 1 relies on these paragraphs of Calabria as being paragraphs that teach "an advertisement set for the item that includes at least one associated advertisement having the item specific visual element, the link,

and at least one search term matching the at least one keyword," as recited in claim 1. However, Appellants assert that these paragraphs are unrelated to the claimed "advertisement set." Instead, these paragraphs disclose ranking advertisements and calculating ClickthruRate and ROAI.

Further, as indicated on page 9 of the Examiner's Answer, these paragraphs are also relied on for teaching the "create a link to information about the item," as recited in claim 1. However, as discussed above, these paragraphs disclose ranking advertisements and calculating ClickthruRate and ROAI. These paragraphs do not teach the claimed "create a link to information about an item."

In sum, nothing in paragraphs [0052]-[0055], [0121] and [0069]-[0072] of Calabria teaches or suggests "a plurality of advertisement generators," where the generators "identify search terms corresponding to an item," "determine at least one item-specific visual element," "create a link to information about the item," and "generate an advertisement set for the item that includes at least one associated advertisement having the item specific visual element, the link, and at least one search term matching the at least one keyword," as recited in Appellants' claim 1. Since, as stated of record, Ford does not make up for these deficiencies, the proposed combination fails to teach such subject matter.

B. The Cited References Do Not Disclose, Teach, or Suggest the "Advertisement Manager" Recited in Claim 1

In the Appeal Brief, Appellants argued that the rejection of claim 1 is improper because, among other reasons, Ford does not teach or suggest an "advertisement manager" that, in the event "an advertisement set is currently submitted to the advertisement placement service for the set of keywords," "determines whether at least one of the generated advertisement sets would avoid conflict with the submitted advertisement set." In response this argument, it is asserted on page 11 of the Examiner's Answer that claim 1 "does not indicate what would be considered a 'conflict.'" It is further stated in the Examiner's Answer that "to understand what would be considered a conflict, Examiner referred to Appellant's disclosure" at [0038], which teaches that, according to one embodiment, "when multiple advertisement sets conflict, the advertisement manager may submit the advertisement sets in a round-robin manner so the effectiveness of each

advertisement set can be assessed and the most effective advertisement set can ultimately be submitted."

Contrary to the Examiner's assertion, Appellants note that Appellant's disclosure at [0038] does not teach "what would be considered a conflict." Instead, the disclosure at [0038] provides an example of what an embodiment of the advertisement system does "when multiple advertisements sets conflict." Further, Appellants note that the cited portion of Ford teaches away from Appellant's disclosure at [0038]. Specifically, Ford at col. 12, lines 9-15 discloses that "in the event that a given keyword maps to multiple advertisements," the "user may . . . impose special conditions, such as requiring a round robin scheduling, so as to avoid repetition of specific advertisements." Thus, Ford discloses using round robin scheduling so as to avoid repetition. On the other hand, Appellant's disclosure at [0038] teaches that "the advertisement manager may submit the advertisement sets in a round-robin manner so the effectiveness of each advertisement set can be assessed and the most effective advertisement set can ultimately be submitted." Since, as stated of record, Calabria does not make up for these deficiencies, the proposed combination fails to teach such subject matter.

In light of at least the foregoing, Appellants respectfully submit that the cited portions of Calabria in view of Ford noted above do not support the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Calabria in view of Ford. Accordingly, reversal of the rejection is respectfully requested.

Independent Claims 9 and 35

Claim 9 recites a method in a computer system for placing advertisements for an advertiser offering an item for consumption. The method of claim 9 comprises, for example, "using each of a plurality of different algorithms to at least: identify search terms corresponding to the item; determine at least one item-specific visual element; create a link to information about the item; and generate an advertisement set for the item that each include at least one associated advertisement having the item-specific visual element, the link, and one or more of the identified search terms." The method of claim 9 further comprises, for example, "determining whether at least one of the generated advertisement sets would avoid conflict with the submitted one or more advertisement sets with respect to the at least one search term of the submitted one or more

advertisement sets" and "when at least one of the generated advertisement sets is determined to avoid conflict . . . selecting . . . an unsubmitted advertisement set that avoids conflict with the submitted one or more advertisement sets."

Claim 35 recites a computer program product embedded in a computer-readable medium and including processor-executable instructions for placing advertisements. The computer program product of claim 35 comprises, for example, "program code for using a plurality of different algorithms to: identify search terms corresponding to the item; determine at least one item-specific visual element; create a link to information about the item; generate an advertisement set for the item that each include at least one associated advertisement having the item-specific visual element, the link, and at least one search term of the identified search terms." The computer program product of claim 35 further comprises "program code for . . . determining whether one or more unsubmitted generated advertisement sets would avoid conflict with the one or more currently submitted advertisement sets with respect to the at least one search term of the one or more currently submitted advertisement sets; and when one or more of the generated advertisement sets is determined to avoid conflict . . . selecting one of the unsubmitted generated advertisement sets determined to avoid conflict."

The rejections to independent claims 9 and 35 cite the same paragraphs of the same references, and use similar arguments, as the rejection to claim 1. Therefore, at least for reasons including some of those discussed above in connection with claim 1 and set forth of record, Appellants respectfully submit that claims 9 and 35 are allowable under 35 U.S.C. § 103 over Calabria in view of Ford since the proposed combination fails to teach or suggest each element of these claims. Accordingly, reversal of these rejections on this basis is respectfully requested.

CONCLUSION

For these reasons, and for the reason set forth in the Appeal Brief, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,

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